

## REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested. Claims 1-11, 13-33 and 35-49 are pending. Claims 1-11, 13-33 and 35-49 are rejected. Claims 1-10, 17-22, 24, 26-33, 38-42, and 45-47 are amended to further clarify the systems and methods of the present invention. No new matter has been added.

### **Rejection of claims 1-11, 13-33 and 35-49 under 35 U.S.C. §103(a)**

Claims 1-11, 13-33 and 35-49 stand rejected under 35 USC 103(a) as unpatentable over US Patent Number 5,590,196 to Moreau in view of US Patent Number 5,282,050 to Ishizuka *et al.* ("Ishizuka"). The Examiner asserts that:

Re claims 1, 24, 40 and 45:

Moreau discloses an apparatus and method for image based transactions (see Moreau Abstract), comprising:

receiving at a first location at least one instrument and cash having a front and back face;

scanning, with a scanner (fax machine or facsimile ), to create a deposited instrument or an electronic validation of deposited cash (see Moreau, col. 1, 11. 46-59);

transmitting an image, with image transmitting means (fax machine or facsimile), of the scanned deposited instrument or cash from the first location to a second location (see Moreau, 12 col. 6, 11. 47 to col. 7, 11. 13); and

transmitting an image of the scanned deposited instrument or cash from the first location to a second location (see col. 6, 11. 47 to col. 7, 11. 13); and

processing a transaction at the second location with the scanned image of the deposited instrument or electronic validation of deposited cash, without verification of the signature of a user initiating the transaction in the case of a deposited instrument, which signature is used to verify that the user is a profiled user with a specified system, whereby pickup of said at least one of an instrument and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location (see col. 6, 11. 47 to col. 7, 11. 13).

Moreau fails to disclose scanning the front and back face of at least one instrument and/or cash.

Ishizuka discloses a fax machine with the ability to scan both sides of a document (see Ishizuka, figs. 2 and 10, Abstract; and col. 1, 11. 33 to col. 2, 11. 19). It would have been obvious for an artisan of ordinary skill at the time of the invention to substitute the fax machine of Moreau for the dual scanning fax machine of Ishizuka because an artisan at the time of the invention would have

considered them art recognized equivalents having no unexpected features to one of ordinary skill in the art.

Furthermore, an artisan or ordinary skill in the art would have recognized the convenience of integrating a dual scanning fax machine into the Moreau system to provide the ability to scan documents with print on both sides. Thus such a modification would have been an obvious expedient to one of ordinary skill in the art.

The undersigned representative respectfully traverses the rejection of the above identified claims under 35 U.S.C. § 103(a) as being unpatentable over Moreau in view of Ishizuka. Regarding claim 1, the cited art, neither singularly nor in combination, teach or suggest, “A method for image based transactions, comprising: receiving at a first location at least one of a check and cash having a front face and a back face; scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash; transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location; and processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location” as recited in claim 1 of the present application. Specifically, the cited art, neither singularly nor in combination, teach or suggest the steps of “receiving at a first location at least one of a check and cash having a front face and a back face; scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash,” as required in claim 1 of the present application (emphasis added).

As admitted by the Examiner, “Moreau fails to disclose scanning the front and back face of at least one instrument and/or cash.” Moreau discloses a secure payment method using facsimile which uses a business payment form 203. Moreau does not teach or suggest that the business payment form is a check or cash. Moreover, Ishizuka is only cited as disclosing “a fax machine with the ability to scan both sides of a document. Therefore, the cited art, neither singularly nor in combination, teach or suggest the steps of “receiving at a first location at least one of a check and cash having a front face and a back face; scanning the front face and the back

face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash,” as required in claim 1 of the present application (emphasis added).

Pursuant to the requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Referring to MPEP Section 2142,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(emphasis added). Thus, since the cited art, neither singularly nor in combination, teach or suggest the steps of “receiving at a first location at least one of a check and cash having a front face and a back face; scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash,” as required in claim 1 of the present application (emphasis added), the Examiner has failed to establish a *prima facie* case of obviousness.

Moreover, since the business payment forms disclosed in Moreau are neither checks nor cash, the business payment forms do not need the front and back sides scanned, thus there is no motivation to combine Moreau and Ishizuka.

For at least these reasons, independent claim 1, as well as dependent claims 2-11 and 13-23 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 24, the cited art does not teach or suggest “A system for conducting image based transactions, comprising: means for accepting as a deposited item at a first location at least one of a check and cash having a front face and a back face; a scanner located at a first location and configured for scanning the front face and the back face of at least one of the check and cash, for creating an image of a deposited check or deposited cash; means for transmitting an image of the scanned deposited check or electronic validation of deposited

cash from the first location to a second location; means for receiving the transmitted image of the scanned deposited check or electronic validation of deposited cash, said means for receiving being located at the second location; and means for processing a transaction with the image of the scanned deposited check or electronic validation of deposited cash at the second location, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location” as required in claim 24 of the present application (emphasis added).

Thus, as stated above with respect to claim 1, the cited art, neither singularly nor in combination, teach or suggest a scanner configured for “scanning the front face and the back face of at least one of the check and cash,” thus the Examiner has failed to establish a *prima facie* case of obviousness. Moreover, as stated above, there is no motivation to combine Moreau and Ishizuka.

For at least these reasons, claim 24, as well as dependent claims 25-33 and 35-39 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 40, the cited art does not teach or suggest “A method for image based transactions, comprising: receiving at a first location at least one of a check and cash having a front face and a back face; scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash; transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location; and processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash without verification of the signature of the user initiating the transaction in the case of a deposited check, which signature is used to verify that the user is a profiled user with a specified system, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location” as required in claim 40 of the present application (emphasis added)..

Thus, as stated above with respect to claim 1, the cited art, neither singularly nor in combination, teach or suggest the step of “scanning the front face and the back face of at least

one of the check and cash," thus the Examiner has failed to establish a *prima facie* case of obviousness. Moreover, as stated above, there is no motivation to combine Moreau and Ishizuka.

For at least these reasons, claim 40, as well as dependent claims 41-44 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 45, the cited art does not teach or suggest "A system for conducting image based transactions, comprising: means for accepting as a deposited item at a first location at least one of a check and cash having a front face and a back face; a scanner located at a first location and configured for scanning the front face and the back face of at least one of the check and cash, for creating an image of a deposited instrument or deposited cash; means for transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location; means for receiving the transmitted image of the scanned deposited check or electronic validation of deposited cash, said means for receiving being located at the second location; and means for processing a transaction with the image of the scanned deposited check or electronic validation of deposited cash at the second location without verification of the signature of a user initiating the transaction in the case of a deposited instrument, which signature is used to verify that the user is a profiled user within a specified system, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location" as required in claim 45 of the present application (emphasis added).

Thus, as stated above with respect to claim 1, the cited art, neither singularly nor in combination, teach or suggest a scanner configured for "scanning the front face and the back face of at least one of the check and cash," thus the Examiner has failed to establish a *prima facie* case of obviousness. Moreover, as stated above, there is no motivation to combine Moreau and Ishizuka.

For at least these reasons, claim 45, as well as dependent claims 46-49 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

The above-identified arguments clearly establish the patentability of the claims over the cited art. The undersigned representative acknowledges that the Examiner has included various other arguments regarding the claim limitations. The undersigned representative does not concede to or agree with these arguments, but instead proffer that these arguments are moot in view of the arguments presented herein. Thus, for at least these reasons, claims 1-11, 13-33 and 35-49 are patentable over Moreau in view of Ishizuka. As a result, the undersigned representative respectfully request that the rejection of claims 1-11, 13-33 and 35-49 under 35 U.S.C. §103(a) be withdrawn.

The foregoing is submitted as a full and complete Response to the non-final Office Action mailed February 3, 2003, and early and favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or if there are any other issues which may be resolved by telephone interview, a telephone call to the undersigned attorney at (202)508-5843 is respectfully solicited. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-1458, and please credit any excess fees to such deposit account.

Respectfully submitted,

Dated:

August 4, 2003

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